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OFFICE OF PETITIONS

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In re Application of	:	
Andrea Leone-Bay et al.	:	
Application No. 10/005,511	:	DECISION ON RENEWED
Patent No. 6,960,355	:	PETITIONS UNDER 37 C.F.R.
Issue Date: November 1, 2005	:	§§1.78(A)(3) AND 1.78(A)(6)
Filed: November 7, 2001	:	
Attorney Docket Number:	:	
1946/1B861-US2	:	
Title: COMPOUNDS AND	:	
COMPOSITIONS FOR DELIVERING	:	
ACTIVE AGENTS	:	

This is a decision on the renewed petitions under 37 C.F.R. §§ 1.78(a)(3) and 1.78(a)(6), filed October 4, 2005, to accept an unintentionally delayed claim under 35 U.S.C. §§120, 365(c) and 119(e) for the benefit of the prior-filed U.S. application 08/414,654, filed on March 18, 1997, PCT application PCT/US96/04580, filed on April 1, 1996, and provisional application number 60/003,111, filed on September 1, 1995, as set forth in the concurrently filed supplemental Application Data Sheet (ADS).

The Office regrets the period of delay in issuing this decision.

The renewed petitions are DISMISSED.

A petition for acceptance of a claim for late priority under 37 C.F.R. §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the

petition is appropriate only after the expiration of the period specified in 37 C.F.R. §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 C.F.R. §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 C.F.R. §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 C.F.R. §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The original petition was submitted on April 11, 2005 and was dismissed via the mailing of a decision on August 4, 2005, for failure to comply with item (1) above. More specifically, the amendment to the Application Data Sheet (ADS) failed to indicate the relationship between the present application and PCT application PCT/US96/04580, as well as the relationship between PCT application PCT/US96/04580 and 08/414,654.

With this renewed petition, Petitioner has submitted an ADS which states the relationship between these applications. However, the ADS has not been signed. Petitioner will note that 37 C.F.R. §1.33(b) requires that amendments and other papers, except for written assertions pursuant to 37 C.F.R. §1.27(c)(2)(ii), filed in the application must be signed by an appropriate party. Therefore, an ADS or a supplemental ADS filed after the filing of an application must be signed in accordance with 37 C.F.R. §1.33(b).

Moreover, the priority claim which is present on the ADS contains a benefit claim to International Application No. PCT/US96/04580, published as WO 96/30036 on October 3, 1996." This reference to the International Application is improper, in that it fails to include the relationship, international application number and international filing date (as opposed to the publication date). See Rule §1.78(a)(2)(i).

Furthermore, the issue fee was submitted on April 11, 2005, and one month after the filing of this renewed petition, the present application issued as U.S. Patent No. 6,960,355.

M.P.E.P. §201(III)(F)(B) sets forth, in pertinent part:

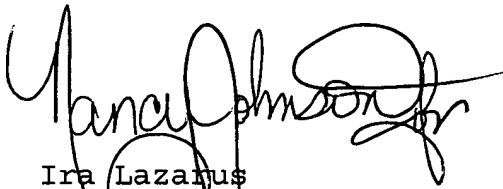
In addition to the petition under 37 C.F.R. 1.78 and the amendment or ADS, to add a benefit claim it may be necessary for applicant to file one of the following, depending on the status of the application...a request for a certificate of correction under 37 C.F.R. 1.323, if appropriate (see MPEP §§ 1402 and 1481), if the application has issued as a patent.

The present application has issued as a patent since the filing of this renewed petition. Therefore, a certificate of correction will be required, pursuant to the portion of the M.P.E.P. cited immediately above, (along with the \$100 fee) as a condition for granting the petition under 37 C.F.R. §1.78(a)(3).

Any response to this decision reply should include a cover letter entitled "Second Renewed Petition Under 37 C.F.R. §§1.78(a)(3) and 1.78(a)(6)". This is not a final agency action within the meaning of 5 U.S.C 704.

The response should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail¹, hand-delivery², or facsimile³.

Telephone inquiries regarding *this decision* should be directed to Paul Shanoski at (571) 272-3225⁴. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Ira Lazarus
Supervisory Petitions Examiner
Office of Petitions
United States Patent and Trademark Office

1 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

2 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

3 (571) 273-8300- please note this is a central facsimile number.

4 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. §1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.